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IN THE
UNITED STATES
PATENT AND TRADEMARK OFFICE

IN RE

APPLICATION OF: Kargman et al

CASE: 57624.010004 (please note new
docket number – prior docket no.
2011783)

APPEAL
REPLY BRIEF
Under 37 CFR §1.193(b)

SERIAL NO: 09/997,578

FILED ON: November 29, 2001

FOR: SYSTEM FOR PLACING
ORDERS THROUGH THE
INTERNET TO A SELECTED
STORE OF A CHAIN OF STORES

Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTENTION OF:
Examiner:
A. Robinson-Boyce
Group Art Unit 3623

Dear Sir:

If any charges or fees must be paid in connection with the following communication, they may be paid out of our Deposit Account No. 50-2428.

Applicants hereby reply to the Examiner's Answer mailed May 4, 2005, in connection with Applicants' appeal to the Board of Patent Appeals and Interferences from the Examiner's final rejection of claims 1-32, which rejection was set forth in the Final Office Action mailed September 2, 2003.

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I. Related Appeals And Interferences

In the Examiner's Answer, the Examiner states that Applicants' brief does not contain a statement identifying related appeals and interferences. However, Section II of Applicants' appeal brief, titled "Related Appeals And Interferences," indicates that no appeals or interferences are known which will directly affect, or be directly affected by, or have bearing on, the Board's decision in the pending appeal. Applicants hereby reaffirm that no such appeals or interferences are known.

II. The Examiner's Comments Concerning The Recitation of Claim 32

In the Examiner's Answer, the Examiner notes a minor error in the recitation of dependent claim 32 in the Appendix of Applicants' brief. Applicants acknowledge that the recitation of claim 32 in the Appendix was in error, and that the Examiner has correctly set forth the wording of claim 32 as it presently exists.

III. The Examiner's Comments Concerning The Rejection of Claims Under 35 U.S.C. § 102

As set forth in Applicants' Appeal Brief, the rejection of claims under 35 U.S.C. § 102 fails to set forth a case of anticipation. The *Cupps et al.* prior art on which the Examiner relies fails to disclose, or even suggest, limitations required by each of Applicants' claims, including the step of "downloading the order directly into the computer system of the selected store, thereby bypassing the order-taking process of the selected store."

A. The *Cupps et al.* Disclosure of Email or Web Communications Does Not Anticipate Applicants' Claimed Inventions

The Examiner continues to rely on the last paragraph of the *Cupps et al.* specification as purportedly disclosing Applicants' "downloading" step, which paragraph states:

In addition, the present invention is not constrained to transmitting a customer's order to the vendor through the interactive voice recognition system as described above. A modem connection can be established which will enable communication between the online ordering machine and the vendor through the Internet thereby allowing email communication, web communication, and the like.

(*Cupps et al.*, col. 12 lines 4-10.)

Notably, the cited portion of *Cupps et al.* merely permits communication between the online ordering machine and the "vendor." It does not at all disclose the direct placement of orders into a vendor's order entry system and bypassing a vendor's order-taking process -- and for good reason. *Cupps et al.* does not contemplate any such direct order entry. For example, Figure 2 of *Cupps et al.*, and the bulk of the *Cupps et al.* disclosure, is directed to communications between online ordering system 106 and vendors via "telephone links 110," to telephone 107M and/or stand-alone fax machine 107A. Such communications clearly require manual order entry activities on the part of the vendor's employees. (See, e.g., *Cupps et al.* col. 10 line 57 to col. 11 line 19.)

After citing the brief reference in *Cupps et al.* to communication between the online ordering machine and the vendor through email communication, web communication and the like, the Examiner concludes that "[t]his web communication would allow the user to skip the voice recognition/fax process and automatically download or upload information to and from the vendor's computer." (Examiner's Answer, page 8.) Applicant respectfully submits that the Examiner's conclusion is entirely unsupported by the disclosure of *Cupps et al.* The brief, conclusory references in *Cupps et al.* to "email communication" and "web communication" fail to disclose or suggest direct order downloading and bypassing of a vendor's order entry process.

In arguing that the disclosure of "web communication" would allow a user to skip the voice recognition/fax process and automatically download or upload information to and from the vendor's computer, it appears that the Examiner has confused the steps of

configuring an order by a customer, and conveying the order to a vendor's point-of-sale system. For example, the Examiner relies on the disclosure of *Cupps et al.* from col. 9 line 8 to col. 10 line 21 as purportedly discussing "the ordering process via web communications." (See Examiner's Answer, page 8.) However, this cited portion of *Cupps et al.* is directed solely to the process by which an end-customer places an order with the online ordering machine. There is no dispute that *Cupps et al.* discloses an automated means by which a customer can place an online order. But that is not the subject of Applicants' recited step of "downloading the order directly into the computer system of the selected store, thereby bypassing the order-taking process of the selected store." Applicants' downloading step is instead directed to the entirely different step of conveying an order, which has already been configured by a user online, to a vendor for fulfillment without further human intervention. Furthermore, the *Cupps et al.* ordering system provides a computer (the online ordering system) that receives order information from a human customer, whereas Applicants' downloading/bypassing process requires direct communication of an order between an online ordering computer system and a vendor's computer system. Thus, the Examiner's reliance on *Cupps et al.* col. 9 line 8 to col. 10 line 21 is misplaced.

While not explained in *Cupps et al.*, to the extent there is any disclosure of communication of orders to a vendor via email or web communications, the logical interpretation of that disclosure requires affirmative human intervention to accomplish manual order entry by the vendor into the vendor's order-taking system. For example, an email order communication to a vendor would logically be received at a vendor email account and manually entered by an employee using the vendor's order taking process. Likewise, a web communication, such as a communication to a message board or via an instant messaging mechanism, would logically be monitored by a vendor's employees

and manually entered using the vendor's order taking process. Neither case anticipates or makes obvious Applicants' claimed inventions.

B. The *Cupps et al.* Disclosure of Facsimile Order Transmission Does Not Anticipate Applicants' Claimed Inventions

In the Examiner's Answer, the Examiner also relies on col. 10 lines 26-31 in support of the contention that when a customer submits an order in *Cupps et al.*, the order can purportedly be "downloaded to the vendor's computer via the facsimile method." (See Examiner's Answer, page 8.) The Examiner goes on to state, without citing any portion of the disclosure of *Cupps et al.*, "the order is downloaded directly to the vendor computer system via order *text file*. Note that since the order text file is a file that is transmittable via computer, the order text file is formatted and transmitted to the vendor via fax without relying solely on human interaction." (Examiner's Answer, pages 8-9.)

At the outset, *Cupps et al.* contains no disclosure of the transmission of an order "text file," as such, to a vendor computer. Indeed, the Examiner does not cite any portion of *Cupps et al.* in support of that conclusion. Rather, *Cupps et al.* clearly requires that the order text be "formatted for facsimile transmission." (*Cupps et al.*, col. 10, lines 27-30.) To Applicants' understanding, facsimile transmissions are graphic or bitmap images, which are typically and conventionally received and interpreted by human recipients. The receipt of such fax transmissions by vendor employee's is further confirmed by the immediately following disclosure in *Cupps et al.* that "[a] voice data file 140 is then generated that informs the vendor 108 of the transmitted fax order (step 320)." (*Cupps et al.*, col. 10 lines 30-32.) If *Cupps et al.* had at all contemplated Applicants' process for bypassing a vendor's order-taking process, it would not include a voice notification to vendor employees when an order was conveyed.

The Examiner's argument also states that the provision of facsimile transmission in *Cupps et al.* does not rely solely on human interaction. However, Applicants do not suggest that the order fulfillment process disclosed in *Cupps et al.* relies solely on human interaction. Reliance solely on human interaction is inapposite to Applicants' claim limitation at issue, which requires downloading the order directly into the computer system of the selected store, thereby bypassing the order-taking process of the selected store.

The Examiner's rejection under 35 U.S.C. § 102 further relies on the purported premise that "[i]n modern technology, a facsimile system can be stored as an application on a computer's hard drive (For example Right Fax software). Therefore, it is not uncommon for the order to be downloaded directly to the vendor's computer when using faxes." (Examiner's Answer, page 9.) Ignoring, for the moment, the question of whether the Examiner's stated premise even anticipates Applicants' claims, the Examiner does not cite any disclosure in *Cupps et al.* of a vendor computer system having integrated facsimile receipt and processing software -- and for good reason. No such disclosure exists. Rather, to the extent *Cupps et al.* discloses facsimile order conveyance at all, the disclosed process contemplates a standalone fax machine -- which would generate paper orders that must be manually entered into the vendor's order processing computer. Again, this understanding is confirmed by the *Cupps et al.* provision of a voice notification to vendor employees, alerting them as to the transmission of a fax order. (*Cupps et al.*, col. 10 lines 30-32.) Thus, the Examiner's anticipation argument under Section 102 must also fail because it relies on information not contained within the cited reference.

Additionally, Applicants note that the present application is a continuation of an application originally filed on March 25, 1999. The Examiner's unsupported conclusions

about the “modern technology” of computer-based facsimile systems, coming over six years after Applicants’ priority date, cannot even provide a legitimate basis for an obviousness rejection under Section 103 -- much less the purported anticipation that is the subject of the present rejection of claims 1-14, 16-24 and 26-30. (See MPEP § 2144.03 (reliance on common knowledge in the art should be rare, and limited to knowledge that is “capable of instant and unquestionable demonstration as to defy dispute”).) Clearly, the rejection under Section 102 is improper.

Finally, even if the unspecified “modern technology” of computer-based facsimile systems constitutes prior art to Applicants’ invention, which Applicant does not at all concede, such a system still would not anticipate Applicants’ claims. Even if a vendor computer receives a facsimile transmission, the Examiner has not cited any disclosure of a process by which a received facsimile order could enable the bypassing of a vendor’s order-taking process -- a required element of Applicants’ claims.

The failure of the combination of *Cupps et al.* and the facsimile “modern technology” relied upon by the Examiner to anticipate Applicants’ claims is further illustrated by consideration of what would be required to use the cited references to bypass a vendor’s order-taking process. As Applicants understand them, facsimile transmissions are essentially graphic or bitmap images. It appears that, to bypass a vendor’s order-taking process using a facsimile transmission, the vendor’s computer would have to be configured to (1) receive a facsimile transmission; (2) recognize that the fax transmission is an order; (3) perform some type of optical character recognition and error-checking procedure to reliably decode the bitmap fax transmission into data representing the nature of the actual order (including customer name and address, items ordered, etc.); and (4) provide a functional link by which the facsimile receipt software can automatically convey the decoded order data into the store’s order processing

system. Even if such a process is possible, it certainly is not disclosed, suggested or enabled by the cited prior art. Rather, such a process would be pure hindsight, based on the teachings of Applicants' present application. Such hindsight cannot form a proper basis for rejection of Applicants' claims.

For the above reasons, as well as those presented in Applicants' opening Appeal Brief, the Examiner's rejection of claims 1-14, 16-24 and 26-30 under 35 U.S.C. § 102 is respectfully traversed.

IV. The Examiner's Comments Concerning The Rejection of Claims Under 35 U.S.C. § 103

The Examiner's rejection of dependent claims 15, 25 and 31 under 35 U.S.C. § 103 relies upon the erroneous conclusion that *Cupps et al.* discloses Applicants' claim limitation of "downloading the order directly into the computer system of the selected store, thereby bypassing the order-taking process of the selected store." (See Examiner's Answer, page 9.) As described in detail above and in Applicants' opening Appeal Brief, the cited prior art does not enable, disclose or even suggest that limitation. Furthermore, while the Examiner's Answer does not set forth any reasons why it might be obvious to modify *Cupps et al.* to implement Applicants' downloading/bypassing limitation, Applicants have set forth numerous reasons why such a modification would not at all be obvious to one of ordinary skill in the art, which reasons are incorporated herein by reference. (See Applicants' Appeal Brief, pages 15-16.)

V. Conclusion

In view of the foregoing, Applicants respectfully submit that errors in the Examiner's rejections of the claims have been shown, and that the rejections have therefore been overcome, such that all claims 1-32 should be deemed allowable. Accordingly, Appellant respectfully requests that the Board withdraw all rejections to the

claims and allow all of claims 1-32 towards ultimate allowance of the application as a whole.

Respectfully Submitted

Dated: 7/5/2005

Howard E. Silverman
Howard E. Silverman
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CERTIFICATE OF MAILING

I hereby certify that this APPEAL REPLY BRIEF is being deposited with the United States Postal Service as First Class Mail on the date indicated below in an envelope postage prepaid and addressed to: Mail Stop Appeal Briefs - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 20231-1450.

Dated: 7/5/2005

Howard E. Silverman